

Remarks

Claims 1-4 are presently pending. Claims 1-4 have been rejected.

The Examiner has rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,315,796 to Gruhlke ("Gruhlke") in view of U.S. Patent No. 5,568,909 to Timko ("Timko") and either U.S. Patent No. US 6,543,391 B2 to Lesko ("Lesko") or U.S. Patent No. 4,386,762 to Collins ("Collins"). With regard to claims 1 and 2, the Examiner asserts that Gruhlke discloses the use of a generally rectangular, plastic, post protective collar member 17 including a closed end 17b, an open end OE and four side walls 17a dimensioned to fit a post 10. The Examiner contends that Gruhlke teaches the basic claimed protector except for the four side walls each having fastener holes and except for the use of weep holes in the bottom wall. However, the Examiner maintains that Timko discloses the use of fastener holes 30 in two of the four side walls. The Examiner states that although Timko only teaches the use of two fastener holes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the structure thereof with two additional holes such that each side wall has a fastener hole disposed therein in order to more securely attach the protective member to the post.

In addition, the Examiner asserts that Timko discloses the use of weep holes 28 and that both Lesko and Collins teach the use of weep holes 23 and 16, respectively, formed in a lower portion of the members 15 and 10. The Examiner contends that although the weep holes of Timko, Lesko and Collins are not disposed in the bottom wall of the members centrally or at the four corners, they are used to both prevent water from collecting and to drain water from the members. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bottom wall of the protective member of Gruhlke with the weep holes of either Timko, Lesko or Collins centrally thereof and in each of the four corners, since the mere arrangement of essential parts of an invention involves only routine skill in the art. The Examiner maintains that selecting the position of the weep holes is governed by which area would provide the optimal run-off of fluid from the member. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the protective member of Gruhlke with the fastener holes of Timko and the weep holes of either Timko, Lesko or Collins in order to securely fasten the protective member to the support post and to allow any water or moisture to properly drain from between the post and the protective member, thereby

decreasing the chance of the member deteriorating from overexposure to external influences.

With regard to claim 3, the Examiner again asserts that the protective collar 17 of Gruhlke is rectangular. Concerning claim 4, the Examiner contends that although the protective member of Gruhlke is rectangular, the Applicants have shown no criticality with respect to a rectangular protective member as opposed to a circular protective member. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a circular collar suitable for the use intended as an obvious matter of design choice. Finally, the Examiner states that a circular collar would perform well with a circular post whereas a rectangular or square collar would perform best with a square post.

This rejection is respectfully but strenuously traversed for the reasons set forth in detail below.

Initially, it is noted that the effective date of Lesko as a reference is February 20, 2001, which is also its filing date. The filing date of the present application is August 14, 2000, which is prior to the effective date of Lesko as a reference. Hence, Lesko is not a prior art reference with regard to the present application. Consequently, the rejection of claims 1-4 as being

unpatentable over the combination of Gruhlke, Timko and Lesko is improper and must be removed.

In general, three basic criteria must be satisfied in order to establish a *prima facie* case of obviousness (M.P.E.P. § 706.02(j)). First, the reference or combination of references must teach or suggest all of the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The rejection fails to satisfy the first criterion of a *prima facie* showing of obviousness. Even the hypothetical combination of Gruhlke, Timko and Collins does not suggest all of the elements of the wooden post protective sleeve defined by claims 1 and 2. Specifically, there is no teaching in any of the cited references of a wooden post protective sleeve comprising a collar having a closed lower end having a central drainage aperture and four corner drainage apertures therethrough for allowing any water on the sleeve or the wooden post therein to drain into a ground area. As the Examiner acknowledges, no component of the protective sleeve of Gruhlke contains drainage apertures therein.

The addition of Timko and Collins to Gruhlke fails to cure this deficiency. The mounting bracket 10 described in Timko has a receiving tube 20 with an open first end 22, an open second end 24 and four side walls 26. A drainage aperture 28, which is present in one of the side walls 26, allows water to exit the receiving tube 20 and thereby prevents any water damage from occurring. The open second end 24 is secured to a base portion 12. Notwithstanding the Examiner's contention to the contrary, Timko provides no indication that the drainage apertures recited in claims 1 and 2 can be incorporated into the bottom wall 17b of the protective sleeve of Gruhlke. Indeed, since the second end 24 is open, the configuration of the receiving tube 20 physically precludes placement of the single aperture 28 in a location corresponding to each of the drainage apertures of the claimed wooden post protective sleeve. Consequently, in order to be positioned beneath a wood post housed in the mounting bracket 10 so that water can drain from the receiving tube 20 as effectively as it does from the wooden post protective sleeves of claims 1 and 2, the aperture 28 would have to be relocated to the base portion 12. However, the disclosure of Timko provides no suggestion whatsoever of this arrangement. In fact, the clearly enunciated intended use of the mounting bracket 10 "on a flat deck for a watertight fit", in sharp contrast to the equally clearly expressed intended use of the present invention in a hole dug in a ground area, renders such a modification highly

impractical, exceptionally unlikely and therefore demonstrably not obvious. (col. 1, lines 6-9; see also col. 1, lines 36-41; col. 1, lines 42-46; col. 3, lines 6-8; col. 4, lines 11-14)

The fence post described in Collins has a tubular member 10 with a stirrup 12 of concrete reinforcing rod welded to its bottom end. The member 10 and the stirrup 12 are set in concrete 14 up to a weep hole 16 drilled in the member at a preset distance from its end. Concrete usually fills the member 10 to the point of the weep hole 16 and thereby facilitates determining the depth to which to set the post. Since its lower end is open and filled with concrete, the configuration of the member 10 physically precludes placement of the weep hole 16 in a location corresponding to each of the drainage apertures of the claimed wooden post protective sleeve. Moreover, because "the weep hole is standardized in its position on the tubular member, it may be used to readily set a uniform height fence." (col. 3, lines 66-68) This method of adjusting the height of the fence is subsequently explained in detail. Thus, the specification of Collins explicitly and repeatedly teaches away from any repositioning of the weep hole 16. Hence, the combined disclosures of Gruhlke, Timko and Collins do not render obvious the wooden post protective sleeves of claims 1 and 2. Claims 3 and 4 depend directly from claim 2 and therefore contain all of its limitations. Consequently, claims 1-4 are

patentably distinct from the cited combinations of references.

Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing remarks, reconsideration and allowance of the pending claims are respectfully solicited. Please remove the rejection of claims 1-4 under 35 U.S.C. § 103(a), and enter the allowance thereof. The Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted, Reg. No. 53,120

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